

REMARKS

Claims 1-2, 4-38 and 44-47 are pending in the application.

Claims 1, 2, 4-38 and 44-47 have been rejected.

Claims 2, 18 and 24 have been canceled, without prejudice.

Claims 1, 4-6, 10, 19-23, 25-26, 29-35, 37-38 and 44-47 have been amended, as set forth herein.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1, 2, 4, 6-9, 11-15, 17-38 and 44-45 were rejected under 35 U.S.C. § 102(e) as being anticipated by Carter (US Patent No. 6,266,782). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant's independent claims have been amended to recite communicating (communicate, a message driver for communicating) with a plurality of stimulus device components using stimulus messaging in accordance with an elemental control protocol (in one claim - specifically reciting SIP as the elemental control protocol). Applicant respectfully submits that Carter fails to disclose or

describe these features/elements. The Office Action asserts (with respect to claim 2 and 4) that Carter discloses a “stimulus message format” and Megaco Protocol, citing Col. 8, lines 45-55 (also asserting Megaco Protocol is inherently disclosed because it is a standard from all communication on the Internet). See, Office Action, page 3.

Applicant respectfully disagrees with the Office Action’s conclusion regarding the disclosure in Carter. Nothing in the cited portion of Carter describes “stimulus messaging” or “elemental control protocols” – as those terms are utilized and described in Applicant’s specification. Moreover, the Megaco Protocol is not a standard used for all communication on the Internet. Applicant directs the Examiner’s attention to the Applicant’s specification, page 9, line 19 thru page 10, line 19, wherein “stimulus messaging” and “element control protocols” are explained and described (two examples of elemental control protocols are given at pages 9-10). Therefore, Applicant respectfully submits that Carter fails to disclose each and every element as recited in Applicant’s claims.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1, 2, 4, 6-9, 11-15, 17-38 and 44-45.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 5, 10, 16, 46 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter (US Patent No. 6,266,782) in view of Marchetti (US Patent No. 6,618,398). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and

the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007))).

Applicant respectfully submits that for the reasons set forth above, the proposed Carter-Marchetti combination fails to render obvious any of the pending claims. Applicant also notes that the assignee of the present application, as well as the assignee of Marchetti, is Nortel Networks Ltd.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 5, 10, 16, 46 and 47.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS CARTER, P.C.

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Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@munckbutrus.com*